

REMARKS

Claims 1-36 are pending in the application. Claims 1, 8, 16, 23, 31, and 35 are independent. By the foregoing Amendment, claim 16 has been amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

Objection to Claim 16

The Examiner objected to claim 16 citing informalities. By the foregoing Amendment, Applicant has amended claim 16 to accommodate the Examiner. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 16.

Rejection of Claims 1, 4-6, 8-11, 23-24, 27-28, 31-32, and 35-36 Under Obviousness-Type

Double Patenting

In the Office Action, the Examiner rejected claims 1, 4-6, 8-11, 23-24, 27-28, 31-32, and 35-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 26-28 of U.S. Patent No. 6,717,965 to Hopkins II, et al. (hereinafter "Hopkins") in view of U.S. Patent No. 6,754,243 to Missey is (hereinafter "Missey"). An obviousness-type double patenting rejection is analogous to a failure to meet the obviousness requirement of 35 U.S.C. §103, thus, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. (MPEP § 804(II)(B)(1) citing *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)). To establish a *prima facie* case of obviousness, an Examiner must show that that there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference(s) teaches each and every element of the claimed invention. (MPEP §2143 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). Applicant respectfully traverses the rejection.

Representative independent claim 1 recites in pertinent part "(a) *a tuning etalon* positioned in a light beam; and (b) a drive element magnetically coupled to said tuning etalon" (emphasis added). In the Office Action, the Examiner cites Hopkins II for claiming "a tuning element positioned in a light beam that is formed by a gain medium, a drive element driving the

tuning element, a cavity reflector that is necessarily positioned after the tuning element, and a grid generator.” The Examiner states that although Hopkins II fails to claim that the tuning element is an etalon, the term “thin film interference means” in claim 26 of Hopkins II invokes 35 U.S.C. 112, paragraph six, and thus the Examiner can look to the Specification of Hopkins II to understand the scope of the term “thin film interference means” The Examiner then states that the term “thin film interference means” is defined throughout the Specification of Hopkins II as an etalon and thus Hopkins II claims an etalon as the tuning means. Applicant respectfully disagrees.

MPEP §2181 provides that a claim limitation will be interpreted to invoke 35 U.S.C. 112, paragraph six, if it uses the phrase “means for” or “step for”, if the phrase “means for” or “step for” is modified by functional language, and if phrase “means for” or “step for” is not modified by sufficient structure, material or acts for achieving the specified function. Applicant respectfully submits that claim 26 of Hopkins II fails to meet the requirements of MPEP §2181 because the “means” in claim 26 of Hopkins II modifies by sufficient structure, to wit: “thin film interference *filter*” (emphasis added). (See *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 54 USPQ.2d 1449 (Fed. Cir. 2000) holding that the word “baffle” itself imparts structure). As such, Applicant respectfully submits that at least this element (i.e., the tuning etalon) is not claimed in Hopkins II and that therefore that using Hopkins II as a basis for the obviousness-type double patenting rejection is improper. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the double patenting rejection of claims 1, 4-6, 8-11, 23-24, 27-28, 31-32, and 35-36.

Rejection of Claims 1-36 Under Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 1-36 under obviousness-type double patenting as being unpatentable over claims 26-28 of U.S. Patent No. 6,788,724 to Sell, et al. (hereinafter “Sell”) in view of Missey. Applicant respectfully traverses the rejection.

Representative independent claim 1 recites in pertinent part “(a) a tuning etalon positioned in a light beam; and (b) a drive element *magnetically coupled* to said tuning etalon” (emphasis added). In the Office Action, the Examiner cites sell for claiming “tuning elements, a

driver, gain medium, reflectors, grid generator, hermetically sealed housing, carbon drain, moisture trap, and inert atmosphere” and that “means for tuning” language invokes 35 U.S.C. 112, paragraph six, bringing “etalon” into the claims from the Specification of Sell. The Examiner then states that Sell does not claim magnetic coupling and magnetic elements but that Missey *teaches* such magnetic coupling and magnetic elements (emphasis added). The Examiner then uses Sell in view of Missey as a basis for the double patenting rejection. Applicant respectfully disagrees with the Examiner.

Rejection of Claims 2-3, 7, 12, 15-18, 22, 25-26, 30, 33-34, and 36 Under 35 U.S.C. §103(a)

The Examiner rejected claims 1-5, 7-10, 12-18, 20-28, and 30-36 under 35 U.S.C. §103(a) as being unpatentable over by U.S. Patent No. 6,108,355 to Zorabedian et al. (hereinafter “Zorabedian”) in view of U.S. Patent No. 6,754,243 to Missey is (hereinafter “Missey”) in further view of U.S. Patent No. 6,396,023 to Aikiyo (hereinafter “Aikiyo”). Applicant respectfully traverses the rejection. To establish a *prima facie* case of obviousness, an Examiner must show three things (1) that there is some suggestion or motivation to modify a reference or combine reference teachings to arrive at the claimed invention and (2) that the references teach or suggest each and every element of the claimed invention, and (3) that there is a reasonable expectation of success. *See* MPEP §2143. Applicant respectfully traverses the rejection.

Rejection of Claims 13-14 and 20-21 Under 35 U.S.C. §103(a)

The Examiner rejected claims 13-14 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian and Missey and Aikiyo in further view U.S. Patent No. 5,696,785 to Bartholomew et al. (hereinafter “Bartholomew”). Applicant respectfully traverses the rejection.

Rejection of Claims 6, 11, 19, and 29 Under 35 U.S.C. §103(a)

The Examiner rejected claims 6, 11, 19, and 29 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian and Missey in further view U.S. Patent No. 6,215,802 to Lunt (hereinafter “Lunt”). Applicant respectfully traverses the rejection.

CONCLUSION

Applicant respectfully submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 11/7/2005

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